

REMARKS

Response to Objection to Drawings

The drawings were objected to by the Examiner, contending that in Figure 12, "64" should apparently read --74--, in Figure 15-16, "12" should apparently read --72--.

In response, applicants have amended Figures 12, 15 and 16 as recommended by the Examiner.

Response to Request for Corrections to Specification

Applicants have reduced the Abstract to less than 150 words in response to the Examiner's requirement.

The disclosure was objected to by the Examiner because of the informality that applicant has not disclosed the current status of the related applications. The issued patent has been appropriately identified.

Response to Claim Objections

Claims 40 and 43 are objected to by the Examiner because of the following informalities:

In claim 40, line 1, "form" should read --from--.

In claim 43, at line 3, "radial" should read --radially--.

In claim 51, at line 3, remove "radially" between "said" and "retracted".

Response to Claim Rejections Under 35 U.S.C. §112

Claims 50-56 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The above amendments to claims 50, 51 and 54 should obviate this rejection.

Response to Claim Rejections Under 35 U.S.C. §102

Claims 1, 40-43, and 47-54 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Kieturakis (U.S. Pat. No. 5,794,626).

The rejected claims all require an electrosurgical cutting element. Applicants have carefully reviewed Kieturakis and believe that the Examiner has misread the reference. Applicants could find no teaching of an electrosurgical cutting element or a high frequency power source. The cited reference does not teach every element of claim 1, 40 and 54, so it cannot anticipate these claims nor the claims which depend from these independent claims. The Examiner makes reference to tissue cutting element 15 as being an electrosurgical cutting element and power source 142 as being a high frequency power source. However, cutting element 15 is a conventional blade with a sharpened edge 17 to cut tissue. The power source 142 is a motor, not a high frequency electrical power source.

Claims 1, 40-46, 49-52, and 54-56 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Essig et al. (U.S. Pat. No. 5,397,320).

Essig et al. describes a morcellation device having a cage-like member 16 which is electrically activated to slice up a specimen placed in the interior of the cage-like member. A plunger member 22 having a flange 24 which presses the tissue against the inside of the cage-like member. Reference is made to cauterizing with the electrically active ribs 14 to control bleeding, but no reference is made to electrosurgical cutting of tissue. The plunger member 22 presses the tissue against the inside of the cage-like member 16 to effect the tissue cutting. There is no teaching of separating the tissue

specimen from the surrounding supporting tissue at the target site. In the device of Essig, the tissue has already been severed from its supporting tissue.

In view of the fact that the cited Essig reference does not teach every feature of the above claims, applicants submit that the reference does not anticipate these claims.

Response to Double Patenting

Claim 1 was rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. patent No. 6,331,166 which has been assigned to the present assignee.

Claims 40, 44-49, and 51-54 were rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,699,206.

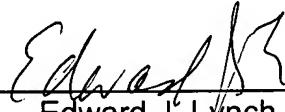
A timely filed terminal disclaimer may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

As indicated above this application and the referenced patents are commonly owed. A Terminal Disclaimer has been filed concurrently herewith. The rejection is thus overcome.

Conclusions

Applicants believe that the pending claims are directed to patentable subject matter. Reconsideration and an early allowance of the claims are earnestly solicited.

Respectfully submitted,

By: 
Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

DUANE MORRIS LLP
One Market
Spear Tower, Ste. 2000
San Francisco, CA 94105
Telephone: (415) 371-2200
Facsimile: (415) 371-2201
Direct Dial: (415) 371-2267

IN THE DRAWINGS

In Figure 12, change reference number "64" to -- 74 --.

In Figure 15, change reference number "12" to -- 72 --.

In Figure 16, change reference number "12" to -- 72 --.



9/11

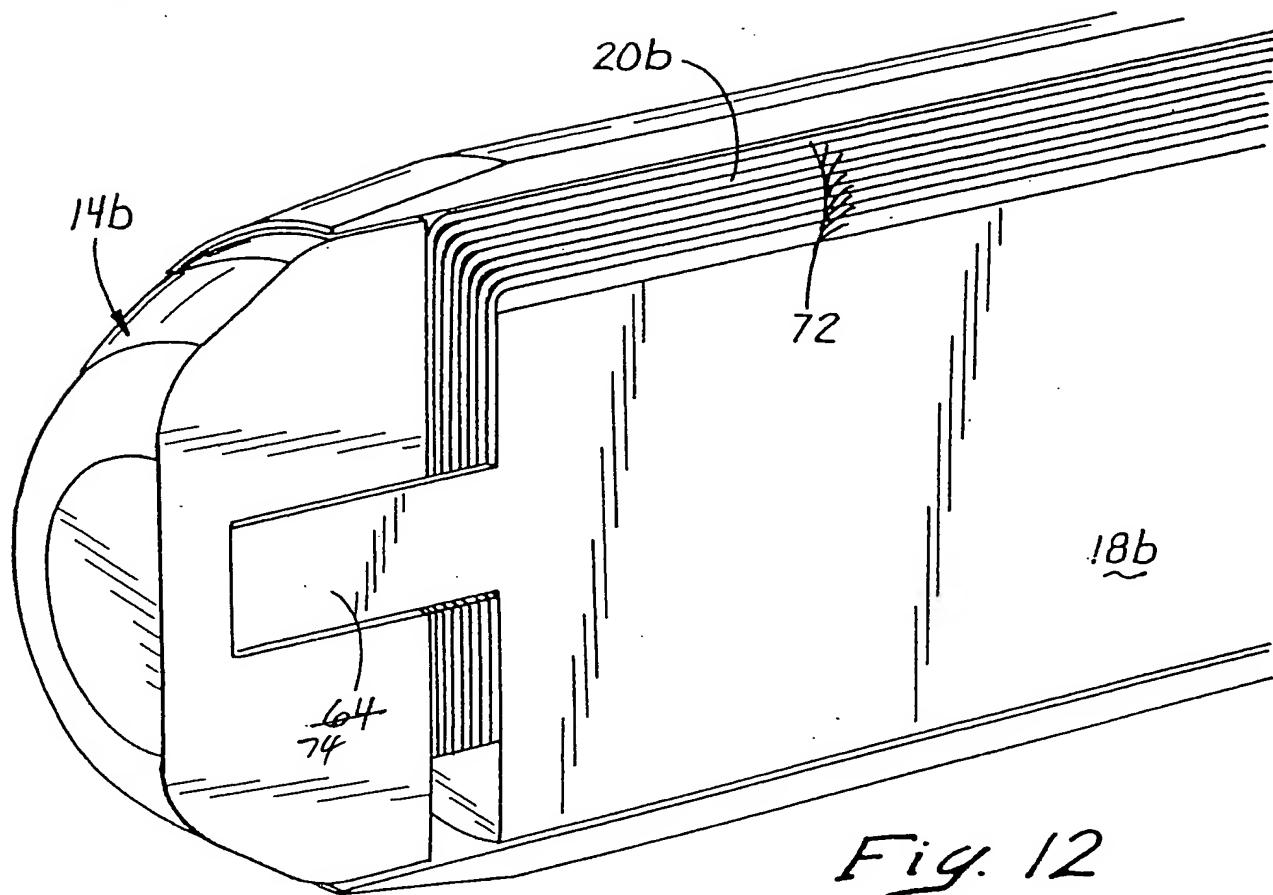


Fig. 12

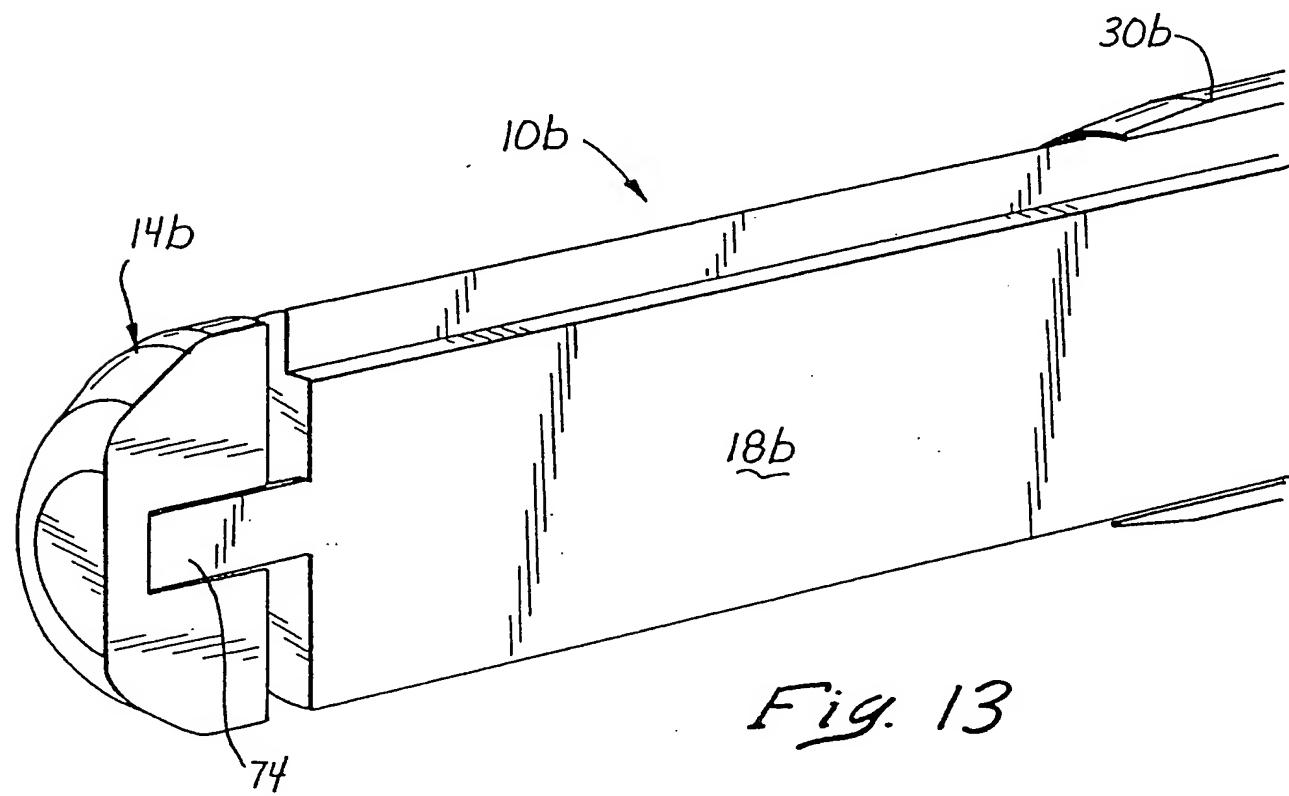


Fig. 13

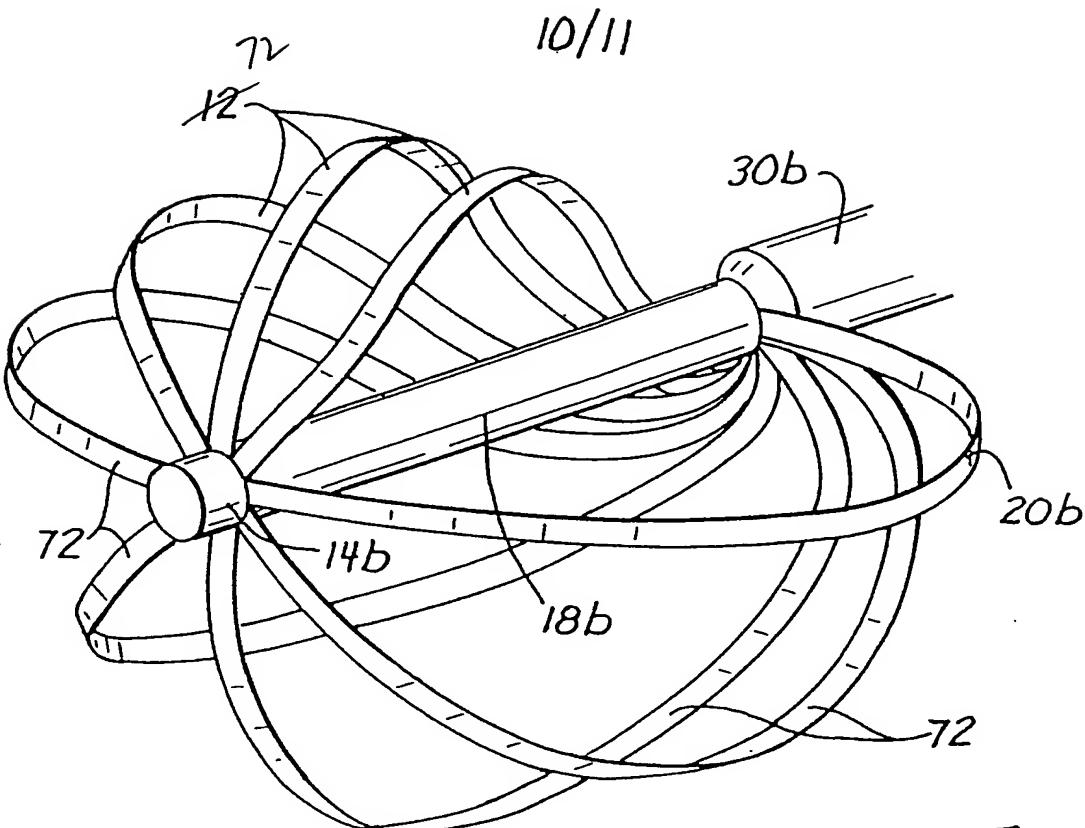


Fig. 15

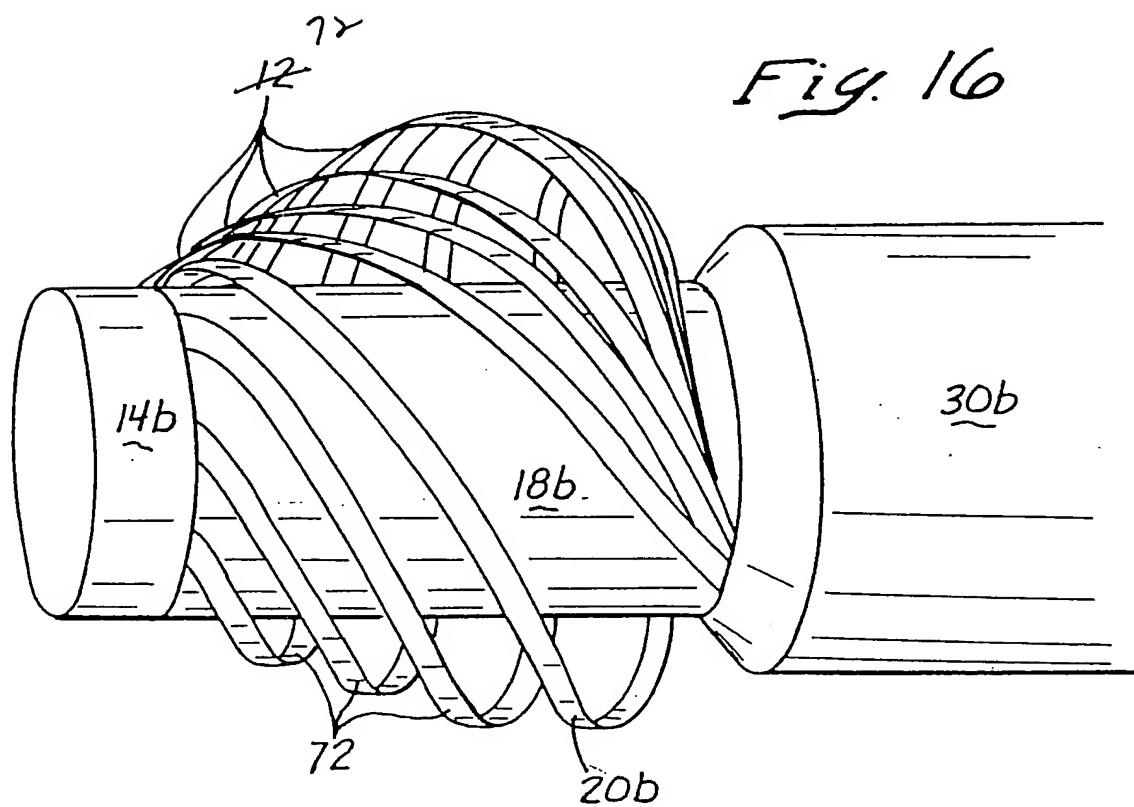


Fig. 16